

REMARKS

Upon Amendment, Claims 1-16 are pending. Claims 4-5 and 9-15 stand withdrawn as directed to non-elected subject matter. Claims 1 and 6 have been amended to conform to the subject matter of newly elected Group II. Claim 16 has been amended to include the names of the compounds listed by example number. Claim 1 has further been amended to include the limitation $q=0$ to the proviso for the ABCDE ring such that when L represents CH and $q=0$ or any G^3 is a monovalent substituent, at least one of A and D is an N atom. No new matter has been added by this amendment.

Applicants respectfully reserve the right to pursue any non-elected, canceled or otherwise unclaimed subject matter in one or more continuation, continuation-in-part, or divisional applications.

Reconsideration and withdrawal of the objections to and the rejections of this application in view of the amendments and remarks herewith, is respectfully requested, as the application is in condition for allowance.

INTERVIEW SUMMARY

Applicants respectfully thank the Examiner for participating with Attorney Nicholas J. DiCeglie, Jr. (Registration No. 51,615) in a telephonic interview on May 22, 2009. During the interview, Mr. DiCeglie indicated that the Applicants wished to switch election groups to Group II at this time.

The Examiner indicated that such a change was possible, but that as an initial search and examination had occurred for the claims of Group I, a Request for Continued Examination would be required. Applicants respectfully thank the Examiner for being amenable to such an change in the restriction group.

As such, and as described above, the claims have been amended to conform to the Election of Group II.

Double Patenting Rejections

While the double patenting rejections were made for originally elected Group I, Applicants will address these rejection as applied to Group II in an effort to advance prosecution.

The Examiner originally rejected Claims 1-5 under 35 U.S.C. 101 for statutory double patenting of claims 1-5 of U.S. Patent No. 6,689,883. Without conceding the validity of the prior rejection, Applicants believe that the amendments to the claims made herein sufficiently distinguish the instant claims from those of U.S. Patent No. 6,689,883. That is to say, the claims of the '883 patent and the instant claims are not coextensive in scope and thus one could infringe the claims of the '883 patent without infringing the instant claims. As such, Applicants believe the rejection under 35 U.S.C. 101 should be withdrawn.

The Examiner also rejected Claims 1-5 and 16 for non-statutory double patenting over claims 1-6 of U.S. Patent No. 6,689,883. Without conceding the validity of the Examiner's rejections, Applicants request that this rejection be held in abeyance until allowance of the instant claims, but for the obviousness-type double patenting rejection..

Rejections under 35 U.S.C 103(a)

The Examiner originally rejected Claims 6-8 under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 5,849,741 to Watanabe et al (Watanabe). While that rejection was made for originally elected Group I, Applicants will address the rejection as applied to Group II in an effort to advance prosecution.

Applicants respectfully traverse.

To properly determine a *prima facie* case of obviousness, the Examiner "must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made." M.P.E.P § 2142. This is important as "impermissible hindsight must be avoided and the legal conclusion must be gleaned from the prior art." *Id.* Four factual inquiries must be made: first, a determination of the scope and contents of the prior art; second, a determination of the differences between the prior art and the claims in issue; third, a determination of level of ordinary skill in the pertinent art; and fourth, an evaluation of evidence of secondary consideration. *Graham v. John Deere*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). Three criteria may be helpful in determining whether

claimed subject matter is obvious under 103(a): first, if there is some suggestion or motivation to modify or combine the cited references; second, if there is a reasonable expectation of success; and third, if the prior art references teach or suggest all the claim limitations. *KSR Int'l Co. v. Teleflex, Inc.* No 04-1350 (U.S. Apr. 30, 2007). With regard to the first criterion, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.3d 690 (Fed. Cir. 1990). “Knowledge in the prior art of every element of a patent claim ... is not of itself sufficient to render claim obvious.” *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1333-34 (Fed. Cir. 2002)]. The issue is whether there is an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *KSR Int'l Co. v. Teleflex, Inc.*

The Examiner states that Watanabe generically overlaps with the claimed genus and refers specifically to examples 70-73 as close compounds.

Applicants respectfully note that Examples 70-73 compounds of Watanabe differ from the claimed invention in that they each have a nitrogen bound piperidino ring at the 1 position of the central ring. That is, the position corresponding to -Y- in the instant claims. Indeed, none of Examples 70-73 have a group corresponding to the -Y- linker of the instant claims. Furthermore, Claims 6-8 are each limited to the situation in which the lower ring (the ABDEL ring) is a phenyl ring whereas the exemplified “lower” rings of Watanabe, when present, always bear a heteroatom.

Applicants respectfully submit that one of ordinary skill in the art would expect significantly different chemical properties (steric, electrochemical, pharmacological, etc) between compounds bearing a linker and a phenyl ring in the “lower” position from those bearing no linker and/or a heteroatom. One of ordinary skill in the art would recognize that such differences, at a minimum, could dramatically affect the ability of the compounds to modulate the same receptors pharmacologically. As such, Applicants respectfully assert that one of ordinary skill in the art, at the time of the invention, would have lacked the motivation to modify the compounds of Watanabe to arrive at the instant compounds without potentially sacrificing the properties of the compounds.

Accordingly, Applicants respectfully request reconsideration and withdrawal of all rejections under 35 U.S.C. § 103.

CONCLUSION

In view of the amendments and remarks made herein, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are respectfully requested. Please charge any required fee or credit any overpayment to Deposit Account No. 04-1105.

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Respectfully submitted,

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